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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,558	05/16/2006	Motoji Ohmori	2006_0739A	3255
52349 7590 04/13/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
NIGH, JAMES D				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
04/13/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,558

Applicant(s)

OHMORI ET AL.

Examiner

JAMES D. NIGH

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendments and remarks filed on 2 February 2009. Claims 1-13 have been amended and are presented for examination on the merits.

Response to Amendment

2. Examiner agrees to withdraw the 35 U.S.C. § 112 second paragraph rejection.

Response to Arguments

3. Applicant's arguments with respect to the 35 U.S.C. § 102 (b) rejection under Hori regarding claims 1, 8 and 11 have been fully considered but are not persuasive. Examiner respectfully points Applicant to paragraphs 0103-0107 of Hori. While paragraphs 0103-0104 generically recite a memory card, in paragraph 0107 Hori recites that "it is not necessary to provide the memory 1415 in the expensive tamper resistant module". The sentence immediately preceding this recitation recites that "since the data stored in memory 1415 is completely encrypted according to the structure shown in FIG. 6, a third party will not be able to reproduce the music with just the data in memory 1415". Thus Hori recites a data management unit having tamper resistance (paragraph 0106) being operable to manage license information and to ensure security of the license information and a storage unit not having tamper resistance, the storage unit being operable to hold the license information (paragraph 0103, "memory 1415 receiving and storing from data bus BS4 a portion of the reproduction information encrypted with public encryption key KPm(1) (content decryption key Kc, content ID, license ID access control information AC1,

reproduction circuit control information AC2), as well as receiving and storing encrypted content data {Data} Kc".

4. Applicant's argument regarding rejections under 35 U.S.C. § 103 (a) have been fully considered but are not persuasive. As Applicant's argument was directed to claims 1, 8 and 11 being patentable over the prior art this argument is moot.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 8 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hori et al. (U.S. Patent PG Publication 2002/0184154, now U.S. Patent 7,340,055, hereinafter referred to as Hori).**

Per the following claims Hori discloses

7. As per claims 1, 8 and 11

data management unit to manage license information (0058, 0082, 0085, 0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256)

storage unit to hold license information (0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256)

secret key unit to store secret key (0013, 0015, 0176)

reproduction condition management or copy subunit to encrypt license with secret key and transfer to license storage unit (0085, 0118, 0148, 0152-0153, 0158, 0169, 0229, 0231)
a data management unit having tamper resistance (0103-0106)
a storage unit not having tamper resistance (0107).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7, 9-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori.
10. As per claims 2, 9 and 12

Hori explicitly discloses reproduction condition management or copy unit includes reading subunit to read license information and secret key (0069, 0070, 0072, 0085-0086, 0093, 0102, 0113-0116, 0118, 0256)

Hori explicitly discloses decryption subunit to decrypt license information with license key (0075, 0099-0100, 0103, 0132, 0134-0136, 0176-0177, 0199, 0204, 0235-0236, 0238-0239)

Hori explicitly discloses information update subunit (0074, 0077)

Hori explicitly discloses overwriting subunit encrypts license information with secret (private) key and stores (0085, 0086, 0102, 0114, 0256)

Hori explicitly discloses a data management unit having tamper resistance (0103-0106)

Hori does not explicitly disclose updating the count when content is used. However, Hori teaches a field for maintaining the count. "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

11. As per claims 3, 10 and 13

Hori explicitly discloses signature data (0222-0227, 0246)

Hori explicitly discloses signature verification (0227)

Hori explicitly discloses a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235)

Hori explicitly discloses a data management unit having tamper resistance (0103-0106)

Hori does not explicitly disclose applying the digital signature to the license ID and usage data. However, Hori teaches digital signatures (0222-0227, 0246) and license ID and usage data (0058, 0082, 0085, 0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Hori does not explicitly disclose storing the digitally signed license ID and usage data. However, Hori teaches storage (0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256) "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

12. As per claim 4

Hori discloses an update history as a count (0074)

Hori does not explicitly disclose the act updating the history or the correspondence table. However, Hori teaches a field for updating the history (0074, 0218) and a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

13. As per claim 5

Hori discloses encrypted content 0011-0012, 0015-0016, 0018, 0047, 0065, 0069, 0095, 0103, 0127, 0140-0141, 0169, 0180-0182, 0186-0187, 0231, 0242-0243)

Hori discloses reproduction information includes usage information (0074, 0218)
Hori explicitly discloses reproduction information includes a content key (0065, 0069, 0071, 0074, 0082, 0087, 0094-0095, 0103, 0127-0129, 0132, 0134-0136,

0140-0141, 0169-0171, 0173-0174, 0176-0177, 0180-0181, 0186-0187, 0199, 0204, 0218, 0231-0233, 0235-0236, 0238-0239, 0242-0243, 0249, 0251, 0253, 0256)

14. As per claim 6

Hori discloses a reproduction condition management subunit encrypts (0069-0070, 0072, 0085-0086, 0093, 0102, 0113-0116, 0118, 0256) and transfers license (0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256)

Hori explicitly discloses a data management unit having tamper resistance (0103-0106)

Hori explicitly discloses a storage unit not having tamper resistance (0107).

Hori does not explicitly disclose an information judgment subunit to determine if license is new. However, Hori teaches a reception log being generated when the license is being downloaded ("or new") (0012, 0015-0016, 0018, 0105, 0137, 0147-0148, 0166-0169, 0178, 0194, 0198-0199, 0204, 0208-0210, 0215, 0219, 0240). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

15. As per claim 7

Hori explicitly discloses data management unit is an IC card (background (0007-0008), 0011, 0019, 0049 0053, 0056, 0058, 0068-0070, 0072, 0074-0075, 0077-0080, 0086-0087, 0093-0094, 0098-0107, 0110, 0112, 0114, 0117-0126, 0129-

0130, 0133-0134, 0141-0143, 0148, 0150-0156, 0161-0166, 0171-0175, 0181-0182, 0187-0188, 0191, 0194-0198, 0208-0211, 0215, 0220, 0224, 0228, 0233-0234, 0237, 0243-0244, 0252, 0256-0258)

Hori explicitly discloses a data management unit having tamper resistance (0103-0106)

Hori does not explicitly disclose that the storage unit is flash memory. However, Hori teaches that the memory can be read and written to which is a characteristic of flash memory (background (0007-0008), 0011, 0019, 0049 0053, 0056, 0058, 0068-0070, 0072, 0074-0075, 0077-0080, 0086-0087, 0093-0094, 0098-0107, 0110, 0112, 0114, 0117-0126, 0129-0130, 0133-0134, 0141-0143, 0148, 0150-0156, 0161-0166, 0171-0175, 0181-0182, 0187-0188, 0191, 0194-0198, 0208-0211, 0215, 0220, 0224, 0228, 0233-0234, 0237, 0243-0244, 0252, 0256-0258)

"One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Please note:

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to

consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685